

Application No. 09/711,049
Amendment dated December 12, 2003
Reply to Office Action of July 7, 2003

REMARKS/ARGUMENTS

Claims 1-40 are pending in the application; the status of the claims is as follows:

Claims 12, 13, 16, 17, 19, and 33 are objected to as being dependent upon a rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 25, 36, 39, and 40 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,678,002 to Fawcett et al ("Fawcett").

Claims 1-4, 7-11, 14, 15, 18, 20-24, 26-32, 34, 35, 37, and 38 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,903,626 to Iglehart et al ("Iglehart").

Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Iglehart as applied to claim 4 above, and further in view of Fawcett.

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicant respectfully requests receipt of this document when it becomes available. Please note that the original drawings filed in the patent application are "formal" drawings.

Claim 15 has been amended by Examiner's Amendment.

Claims 1, 15, 20, 22, 25-27, 35-37 and 39 have been amended to more clearly distinguish the prior art. These changes do not introduce any new matter.

Claim 15 has been rewritten in independent form. These changes are not necessitated by the prior art, are unrelated to the patentability of the invention over the prior art, and do not introduce any new matter.

Claim 35 has been amended to correct grammar. This change is not necessitated by prior art and does not introduce any new matter.

Application No. 09/711,049
Amendment dated December 12, 2003
Reply to Office Action of July 7, 2003

Claims 12, 13 and 19 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Claims 12, 13 and 19 depend from and contain all the limitations of claim 1. For the reasons presented in detail below, claim 1 is believed to allowable. Thus, claims 12, 13 and 19 have not been rewritten in independent form.

Claims 16 and 17 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Claims 16 and 17 depend from and contain all the limitations of claim 15. For the reasons presented in detail below, claim 15 is considered to be allowable. Thus, claims 16 and 17 have not been rewritten in independent form.

Claim 33 has been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Claim 33 depend from and contain all the limitations of claim 27. For the reasons presented in detail below, claim 27 is considered to be allowable. Thus, claim 33 has not been rewritten in independent form.

Accordingly, it is requested that the objection to Claims 12, 13, 16, 17, 19 and 33 be reconsidered and withdrawn.

35 U.S.C. § 102(b) and (e) Rejections

The rejection of claims 25, 36, 39, and 40 under 35 U.S.C. § 102(b) as being anticipated by Fawcett, is respectfully traversed based on the following.

Claim 25 requires, *inter alia*, that the inspection program be adapted for execution on said electronic device on said customer's side under instructions from the customer. Such instructions may be provided by a specific action by the user to initiate the inspection program or automatically in response to a user action, such as operation of various types of switches or loading of media. While Fawcett discloses a method in which a diagnostic agent is downloaded to the customer's computer, the diagnostic agent is executed by the

Application No. 09/711,049
Amendment dated December 12, 2003
Reply to Office Action of July 7, 2003

following process: the support client forwards the execute command to the support agent, which then starts the requested diagnostic agent on the customer's computer. (Col. 8, ll. 14-21). Thus, execution of the inspection program is controlled by the support client and not "under instructions from the customer" as required by claim 25. Fawcett, therefore, fails to anticipate claim 25.

Claim 36 requires, *inter alia*, that the inspection program be adapted for execution on said electronic device on said customer's side under instructions from the customer. As noted above, such instructions may be provided by a specific action by the user to initiate the inspection program or automatically in response to a user action, such as operation of various types of switches or loading of media. Also as discussed above, execution of the diagnostic agent of Fawcett is controlled by the support client. Thus, Fawcett fails to disclose an apparatus in which the inspection program is adapted for execution "under instructions from the customer." Fawcett, therefore, fails to anticipate claim 36.

Claim 39 requires, *inter alia*, that the inspection program be adapted for execution on said electronic device on said customer's side under instructions from the customer. As noted above, such instructions may be provided by a specific action by the user to initiate the inspection program or automatically in response to a user action, such as operation of various types of switches or loading of media. Also as discussed above, execution of the diagnostic agent of Fawcett is controlled by the support client. Thus, Fawcett fails to disclose that the inspection program is adapted for execution "under instructions from the customer." Fawcett, therefore, fails to anticipate claim 39.

Claim 40 depends from claim 39 and includes all the limitations thereof. Since Fawcett fails to anticipate claim 39, Fawcett cannot anticipate claim 40.

Accordingly, it is respectfully requested that the rejection of claims 25, 36, 39, and 40 under 35 U.S.C. § 102(b) as being anticipated by Fawcett, be reconsidered and withdrawn.

Application No. 09/711,049
Amendment dated December 12, 2003
Reply to Office Action of July 7, 2003

The rejection of claims 1-4, 7-11, 14, 15, 18, 20-24, 26-32, 34, 35, 37, and 38 under 35 U.S.C. § 102(e) as being anticipated by Iglehart, is respectfully traversed based on the following.

Claims 1 requires, *inter alia*, receiving an inspection result obtained by executing an inspection program on said electronic device on said customer's side under instructions from the customer. As noted above, such instructions may be provided by a specific action by the user to initiate the inspection program or automatically in response to a user action, such as operation of various types of switches or loading of media. Iglehart discloses a device which contains built-in troubleshooting programs 14 (fig. 1; col. 3, ll. 56-58; col. 4, ll 24-28). Execution of the troubleshooting programs is controlled by a diagnostic device, which transmits signals to the phone to activate the programs. Thus, execution of the inspection program of Iglehart is controlled by the diagnostic device, and not "under instructions from the customer" as required by claim 1. Iglehart, therefore, fails to anticipate claim 1.

Claims 2-4, 7-11, 14 and 18 depend from and contains all the limitations of claim 1. Since Iglehart fails to anticipate claim 1, Iglehart cannot anticipate claims 2-4, 7-11, 14 and 18.

Claim 15 requires, *inter alia*, that the diagnosis results include information indicating a state selected from the group comprising a first state where the electronic device is normal, a second state where the electronic device has trouble but needs no repair, and a third state where the electronic device needs repair.

The Office Action cites the "necessary repairs, if any" language from col. 5, l. 5 of Iglehart as implying that some sort of indication is included in the diagnosis result to distinguish between malfunctioning devices needing repair and malfunctioning devices not needing repair. Applicants respectfully disagree. Iglehart discloses that its method can be used to diagnose malfunctioning phones, as well as phones for which no malfunctions have been reported in order to correct malfunctions before they are noticed by the

customer. If no malfunctions are found, then no repair is necessary. Thus, while Iglehart does state that repairs, if any, are performed after diagnosis, this statement can be interpreted to simply mean that a device which no malfunctions have been reported may not need any repairs, and thus no repair is performed on such device. There is no indication that the quoted phrase means that the device has been diagnosed to be in a state where it has trouble but needs no repair as recited in Claim 15. Thus, because Iglehart fails to disclose every limitation of claim 15, Iglehart cannot anticipate claim 15.

Claim 20 requires, *inter alia*, receiving an inspection result carried in a computer-readable medium, said inspection result obtained by executing an inspection program on said electronic device on said customer's side under instructions from the customer. As noted above, such instructions may be provided by a specific action by the user to initiate the inspection program or automatically in response to a user action, such as operation of various types of switches or loading of media. Also as discussed above, Iglehart discloses a device which contains built-in troubleshooting programs. Execution of the troubleshooting programs is controlled by a diagnostic device, which transmits signals to the phone to activate the programs, and is not "under instructions from the customer" as required by claim 20. Iglehart, therefore, fails to anticipate claim 20.

Claim 21 depends from and includes the limitations of claim 20. Since Iglehart fails to anticipate claim 20, Iglehart cannot anticipate claim 21.

Claim 22 requires, *inter alia*, that the inspection result be obtained by executing an inspection program on said electronic device on said customer's side under instructions from the customer. As noted above, such instructions may be provided by a specific action by the user to initiate the inspection program or automatically in response to a user action, such as operation of various types of switches or loading of media. Also as discussed above, in the telephone of Iglehart, execution of the troubleshooting programs is controlled by a diagnostic device, which transmits signals to the phone to activate the

Application No. 09/711,049
Amendment dated December 12, 2003
Reply to Office Action of July 7, 2003

programs, and is not "under instructions from the customer" as required by claim 22. Thus, Iglehart fails to anticipate claim 22.

Claims 23-24 depend from and include the limitations of claim 22. Since Iglehart fails to anticipate claim 22, Iglehart cannot anticipate claims 23-24.

Claim 26 requires, *inter alia*, that the inspection program be executed on the customer's side under instructions from the customer. As noted above, such instructions may be provided by a specific action by the user to initiate the inspection program or automatically in response to a user action, such as operation of various types of switches or loading of media. Also as discussed above, execution of the troubleshooting programs in Iglehart's telephone is controlled by a diagnostic device, which transmits signals to the phone to activate the programs, not "under instructions from the customer" as required by claim 26. Thus, Iglehart fails to anticipate claim 26.

Claim 27 requires, *inter alia*, that the inspection program be executed on the customer's side under instructions from the customer. As noted above, such instructions may be provided by a specific action by the user to initiate the inspection program or automatically in response to a user action, such as operation of various types of switches or loading of media. Execution of the troubleshooting programs in the telephone of Iglehart is controlled by a diagnostic device, which transmits signals to the telephone to active programs already contained in the telephone. Therefore, Iglehart does not disclose that the inspection program is executed under instructions from the customer as recited in claim 27. Thus, Iglehart fails to anticipate claim 27.

Claims 28-32, 34 and 35 depend from and include the limitations of claim 27. Since Iglehart fails to anticipate claim 27, Iglehart cannot anticipate claims 28-32 and 34-35.

Claim 37 requires, *inter alia*, that the inspection program executed on the customer's side under instructions from the customer. As noted above, such instructions

Application No. 09/711,049
Amendment dated December 12, 2003
Reply to Office Action of July 7, 2003

may be provided by a specific action by the user to initiate the inspection program or automatically in response to a user action, such as operation of various types of switches or loading of media. Also as discussed above, execution of the troubleshooting programs in the telephone of Iglehart is controlled by the diagnostic device transmitting signals to telephone. Therefore, Iglehart does not disclose that the inspection program is executed under instructions from the customer as recited in claim 37.

Claim 38 depends from and includes the limitations of claim 37. Since Iglehart fails to anticipate claim 37, Iglehart cannot anticipate claim 38.

Accordingly, it is respectfully requested that the rejection of claims 1-4, 7-11, 14, 15, 18, 20-24, 26-32, 34, 35, 37, and 38 under 35 U.S.C. § 102(e) as being anticipated by Iglehart, be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejection

The rejection of claims 5 and 6 under 35 U.S.C. § 103(a), as being unpatentable over Iglehart as applied to claim 4 above, and further in view of Fawcett, is respectfully traversed based on the following.

Claims 5 and 6 depend from and include all the limitations of claim 1. As discussed above, Iglehart does not disclose every element of claim 1. Specifically, Iglehart does not disclose execution of the inspection program under instructions from the customer.

Fawcett is directed to a system and method in which a diagnostic agent is downloaded to the customer's computer. The diagnostic agent is executed by the following process: the support client forwards the execute command to the support agent, which then starts the requested diagnostic agent on the customer's computer. Thus, Fawcett discloses that execution of the inspection program is controlled by the support client and not "under instructions from the customer." Fawcett does not rectify the

Application No. 09/711,049
Amendment dated December 12, 2003
Reply to Office Action of July 7, 2003

deficiencies of Iglehart in that Fawcett also fails to disclose that the inspection program is adapted for execution under instructions from the customer.

Thus, neither Iglehart nor Fawcett, alone or in combination, discloses that the inspection program is adapted for execution under instructions from the customer as disclosed in claim 1, 5 and 6.

Accordingly, it is respectfully requested that the rejection of claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Iglehart as applied to claim 4 above, and further in view of Fawcett, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment increases the number of independent claims by 1 from 9 to 10, but does not increase the total number of claims and does not present any multiple dependency claims. Accordingly, a Response Transmittal and Fee Authorization form authorizing the amount of \$86.00 to be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260 is enclosed herewith in duplicate. However, if the Response Transmittal and Fee Authorization form is missing, insufficient, or otherwise inadequate, or if a fee, other than the issue fee, is required during the pendency of this application, please charge such fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Application No. 09/711,049
Amendment dated December 12, 2003
Reply to Office Action of July 7, 2003

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By: 

Tung T. Nguyen
Registration No. 42,935
Attorney for Applicant

TTN/llb:jk
SIDLEY AUSTIN BROWN & WOOD LLP
717 N. Harwood, Suite 3400
Dallas, Texas 75201
Direct: (214) 981-3478
Main: (214) 981-3300
Facsimile: (214) 981-3400
December 12, 2003